

**AMENDMENT UNDER 37 C.F.R. 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 2194
PATENT**

Serial No. 09/506,640

Attorney Docket No. 1999P07475US01 (1009-023)

REMARKS

The Examiner is respectfully thanked for the consideration provided to this application. Reconsideration of this application is respectfully requested in light of the foregoing amendments and the following remarks.

Each of claims 10, 21, 36, 40, 50, and 51 has been amended solely for either addressing an informality or correcting a typographical error, thus explicitly presenting one or more elements implicit in the claim as originally written when viewed in light of the specification, and therefore not changing the scope of the claim.

Each of claims 1-25, 27, 28, 30-40, 42, 43, and 45-62 is pending in this application. Claims 1, 13, 21, 36, and 51 are in independent form.

I. The Obviousness Rejections

Each of claims 1-25, 27-28, 30-40, 42-43, and 45-62 was rejected under 35 U.S.C. 103(a) as being unpatentable over Koppolu (U.S. Patent No. 6,460,058) in view of Bonet (U.S. Patent No. 6,564,242). These rejections are respectfully traversed.

A. Official Notice

To the extent that official notice is explicitly or implicitly utilized to support any rejection, that rejection is respectfully traversed and citation and provision of a reference that supports the rejection is respectfully requested. *See* MPEP 2144.03. Specifically, the present Office Action, at Page 6, recites:

[a]s to claims 24 and 25, Koppolu does not explicitly disclose USB and COM connections. However, Koppolu as modified further teaches that other physical connections to the computer network alternatively can be used (lines 38-40

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column 8). It would have been obvious to consider that these physical connections could be USB or COM since such teachings are conventional.

Applicant respectfully requests citation and provision of the apparent Official Notice inherent within this statement from the present Office Action.

B. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." See MPEP § 2143. Moreover, the USPTO "has the initial duty of supplying the factual basis for its rejection." *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (C.C.P.A. 1967).

C. Missing Claim Limitations Claim 1

The present Office Action purports to find matter in Koppolu that is not present therein. Claim 1 recites, yet Koppolu fails to teach or suggest, expressly or inherently, "a specific instance associated with a programmable logic controller comprising a first operating system, wherein said programmable logic controller is communicatively coupled to a server running under a second operating system on a personal computer."

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The present Office Action erroneously recites that “for a specific instance (instance data structure of an object, lines 9-11 column 11) comprising a first operating system, line 58 column 11) communicates to a server running under a second operating system on a personal computer (operating system running under server 100, Fig. 5).” *See* Page 2.

Instead of teaching or suggesting, either expressly or inherently, the claimed subject matter, Koppolu defines the “server” allegedly illustrated in Fig. 5 by allegedly reciting “[r]eferring now to FIG. 5, the virtual function table 84 and member functions 86-88 of the object 80 are provided by a server application program 100 which is stored in the computer system 20 (FIG. 1) as an executable program file (with a “.exe” file name extension) or as a dynamic link library file (with a “.dll” file name extension).” *See* col. 11, lines 51-56.

Where does Koppolu teach or recite that the “server application program” “stored” “as an executable program file” or as a “dynamic link library file” is associated with a second operating system as asserted in the present Office Action? Applicant respectfully submits that Koppolu fails to teach or suggest, expressly or inherently, this claim limitation.

Instead, the processes described in Koppolu relating to Fig. 5 take place within a single “computer.” *See* e.g., col. 15, lines 1-14. Koppolu recites only a single operating system associated with this “computer”, as illustrated in Fig. 1. *See* e.g., col. 7, line 64 – col. 8, line 1.

Moreover, Claim 1 recites, yet Koppolu fails to teach or suggest, expressly or inherently, “determining that said specific instance is not registered with said second operating system and that said specific instance is already running under said first operating system; and utilizing a moniker, automatically registering said specific instance with said second operating system, such that said specific instance, is accessible by said server by checking a running object table of said second operating system.”

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Koppolu allegedly recites when “the moniker 120 can look in the running objects table ... [I]f the object exists, the moniker 120 can simply return an interface pointer of the existing object to the client 104, and thus avoid creating the object again”. See col. 15 lines 60-63. Thus, Koppolu creates objects referenced by “moniker 120” that are not present in “the running objects table,” but does not teach or suggest, expressly or inherently, “registering” instances that are already “running.”

In response to this previously presented argument, the present Office Action claims, regarding Koppolu, that “the reference describes the process of checking already running objects of whether they are already registered with the system or not. If they are, the system does not need to register the objects again (lines 60-66 column 15).” See Page 8.

Instead of the characterization asserted in the present Office Action, the referenced lines in Koppolu actually recite that “[w]hen called by the client to bind to the named object 80 for example, the moniker 120 can look in the running objects table of the bind context 126 to determine whether the object already exists. If the object exists, the moniker 120 can simply return an interface pointer of the existing object to the client 104, and thus avoid creating the object again. Other uses of the bind context are described in *Inside OLE, second edition, supra.*”

Where does Koppolu teach or suggest, expressly or inherently, the claimed elements for independent claims 1? For example, where does Koppolu teach or suggest, expressly or inherently, “determining that said specific instance is not registered in a running object table of said second operating system and that said specific instance is already running under said first operating system; and utilizing a moniker, registering said specific instance with said second operating system such that said specific instance of said object, that was previously not registered with said second operating system such that said server was not able to normally

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access said specific instance, is accessible by said server by checking said running object table of said second operating system”? Applicant respectfully submits that Koppolu fails to teach or suggest, expressly or inherently, these claimed elements.

Bonet fails to overcome the deficiencies of Koppolu. Accordingly, Applicant respectfully requests the withdrawal of the rejection of claim 1.

D. Claim 2

Claim 2 recites, “said step of registering does not instantiate objects that are not running such that a dormant programmable logic controller is not erroneously activated.”

The present Office Action recites that “Koppolu as modified further teaches registering does not instantiate objects that are not running (254-259, Fig. 8A). See Page 4. Applicant respectfully traverses this contention as factually erroneous.

Fig. 8A of Koppolu allegedly illustrates the following flowchart steps:

254 – “object is running?”

255 – if “object is running”, “retrieve object”

256 – if “object” is not “running” “get bind information from client’s bind status callback

257 – if “object” is not “running” “initiate binding with transport”

258 – if “object” is not “running” “pass transport’s IBINDING to client via
IBINDSTATUSCALLBACK::ONSTARTBINDING

259 – if “object” is not “running” “return MK_S_ASYNCROUS and null
object pointer from IMONIKER::BINDTOOBJECT.

Regarding “BINDTOOBJECT” function, Koppolu allegedly recites, “[i]n the moniker’s BindToObject function, the moniker 120 includes code which launches the object’s server

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application program 100, requests creation of the named object, and queries for a pointer to the interface requested by the client. See col. 16, lines 40-43.

How do these steps or Koppolu as modified teach or suggest, expressly or inherently, “said step of registering does not instantiate objects that are not running such that a dormant programmable logic controller is not erroneously activated”? Applicant respectfully submits that Koppolu, as modified, fails to teach or suggest, expressly or inherently, this claim limitation.

Bonet fails to overcome the deficiencies of Koppolu. Accordingly, Applicant respectfully requests the withdrawal of the rejection of claim 2.

E. Missing Claim Limitations Claim 13

Claim 13 recites, yet Koppolu fails to teach or suggest, expressly or inherently, “a specific instance of an object associated with a first operating system, wherein said specific instance is not registered with a second operating system such that a server running under said second operating system is not able to normally access said specific instance.”

Regarding claim 13, the present Office Action recites “[a]s to claim 13, it is a method claim of claims 1-3. Therefore, it is rejected for the same reasons as claim 1-3 above.” See Page 5.

As stated above in section I.C., Koppolu recites only a single operating system. See e.g., col. 7, line 64 – col. 8, line 1. Moreover, claim 13 recites, yet Koppolu (as demonstrated above in section I.C.) fails to teach or suggest, expressly or inherently, “determining that said specific instance is not registered in a running object table of said second operating system and that said specific instance is already running under said first operating system; and utilizing a moniker, registering said specific instance with said second operating system such that said specific instance of said object, that was previously not registered with said second operating

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system such that said server was not able to normally access said specific instance, is accessible by said server by checking said running object table of said second operating system.”

Bonet fails to overcome the deficiencies of Koppolu. Accordingly, Applicant respectfully requests the withdrawal of the rejection of claim 13.

F. Missing Claim Limitations Claim 21

Claim 21 recites, yet Koppolu fails to teach or suggest, expressly or inherently, “**a memory adapted to store a specific instance, said memory associated with a programmable logic controller that comprises a first operating system**” and “**via a moniker, provide access to said specific instance via a personal computer comprising a second operating system such that said specific instance of said object is accessible by a server associated with said personal computer by accessing a running objects table of said second operating system.**”

The present Office Action relies upon the same reasoning in rejecting the claimed subject matter comprised in claim 21 as in rejecting the claimed subject matter of claim 1. As demonstrated above in section I.C., Koppolu recites only a single operating system associated with a single “computer”, as illustrated in Fig. 1.

In addition, claim 21 recites, yet Koppolu (as demonstrated above in section I.C.) fails to teach or suggest, expressly or inherently, “**a memory adapted to store a specific instance, said memory associated with a programmable logic controller that comprises a first operating system**” and “**register said specific instance with said first operating system; and via a moniker, provide access to said specific instance via a personal computer comprising a second operating system such that said specific instance of said object is accessible by a server associated with said personal computer by accessing a running objects table of said second operating system.**”

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Bonet fails to overcome the deficiencies of Koppolu. Accordingly, Applicant respectfully requests the withdrawal of the rejection of claim 21.

G. Missing Claim Limitations Claim 36

Claim 36 recites, yet Koppolu fails to teach or suggest, expressly or inherently, “**memory means adapted to store a specific instance, said memory associated with a programmable logic controller that comprises a first operating system**” and “**via a moniker, provide access to said specific instance via a personal computer comprising a second operating system such that said specific instance of said object is accessible by a server associated with said personal computer by accessing a running objects table of said second operating system.**”

As demonstrated above in section I.C., Koppolu recites only a single operating system associated with a single “computer”, as illustrated in Fig. 1.

Also, Claim 36 recites, yet Koppolu (as demonstrated above in section I.C.) fails to teach or suggest, expressly or inherently, “**register said specific instance with said first operating system; and via a moniker, provide access to said specific instance via a personal computer comprising a second operating system such that said specific instance of said object is accessible by a server associated with said personal computer by accessing a running objects table of said second operating system.**”

Bonet fails to overcome the deficiencies of Koppolu. Accordingly, Applicant respectfully requests the withdrawal of the rejection of claim 36.

H. Missing Claim Limitations Claim 51

Claim 51 recites, yet Koppolu fails to teach or suggest, expressly or inherently, “**for a specific instance of an object associated with a first operating system, wherein said specific**

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instance is not registered with said second operating system such that a server of said second operating system is not able to normally access said specific instance.”

As stated above in section I.C., Koppolu recites only a single operating system. *See e.g.*, col. 7, line 64 – col. 8, line 1.

In addition, claim 51 recites, yet Koppolu (as demonstrated above in section I.C.) fails to teach or suggest, expressly or inherently, “determining that **said specific instance is not registered in a running object table of said second operating system and that said specific instance is already running under said first operating system; and utilizing a moniker, registering said specific instance with said second operating system such that said specific instance of said object, that was previously not registered with said second operating system such that said server was not able to normally access said specific instance, is accessible by said server by checking said running object table of said second operating system.”**

Bonet fails to overcome the deficiencies of Koppolu. Accordingly, Applicant respectfully requests the withdrawal of the rejection of claim 51.

I. Suggestion or Motivation to Combine Koppolu with Bonet

“The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.” MPEP 2142. According to the Federal Circuit the “mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Fritch*, 972 F.2d 1260, 23 USPQ 2d 1780, 1783-1784 (Fed. Cir. 1992) (citing *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988) (emphasis added)). In that same case, the Federal Circuit further held that it “is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is

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rendered obvious. This court has previously stated that ‘[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.’” *Id.*, 23 USPQ 2d at 1784.

Instead, “**obviousness requires proof** ‘that the skilled artisan . . . would select the elements from the cited prior art references for combination in the manner claimed’”. *In re Scott E. Johnston* (Fed. Cir. 30 January 2006) (quoting *In re Rouffet*, 149 F.3d 1350, 1358 (Fed. Cir. 1998) (emphasis added)). To make that proof, the Office Action must present sufficient evidence of some ““suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to””:

1. ““select the references””;
2. “select the teachings of [the] separate references”; and
3. ““combine [those teachings] in the way that would produce the claimed invention””.

Id. See also *In re Dance*, 160 F.3d 1339, 1343 (Fed. Cir. 1998) (discussing the “the test of whether it would have been obvious to select specific teachings and combine them as did the applicant”) (emphasis added); and *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143 (Fed. Cir. 1985) (“When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself.”).

Moreover, “[w]hen determining the patentability of a claimed invention which combines two known elements, the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.” *Akamai Techs. v. Cable & Wireless Internet Servs.*, 344 F.3d 1186, 68 USPQ 2d 1186 (Fed. Cir. 2003) (emphasis added).

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The Office Action presents **no evidence of anything** "in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination." Moreover, the Office Action presents **no evidence of any** "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed invention".

Instead of meeting this standard, the present Office Action recites "[i]t would have been obvious to apply the teachings of Bonet to the system of Koppolu because the specific instance of Koppolu **could be associated** with a programmable logic controller wherein this specific instance is being used by the client program to control the operation of a distributed automation system as disclosed by Bonet (lines 41-53 column1)." *See Page 4.*

The mere fact that two references "**could be**" combined fails to comply with the legal requirement for a *prima facie* case of obviousness. The present Office Action utterly fails to provide evidence that anything in "the prior art as a whole" suggests "the desirability" of the proposed combination.

Accordingly, applicant respectfully requests a withdrawal of each rejection based upon the proffered combination of Bonet and Koppolu.

J. Conclusion – Nonobviousness

Thus, even if there were motivation or suggestion to modify or combine the cited references (an assumption with which Applicant disagrees), and even if there were a reasonable expectation of success in combining or modify the cited references (another assumption with which Applicant disagrees), the cited references still do not teach or suggest, expressly or

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inherently, **every** limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness.

Because no *prima facie* rejection of any independent claim has been presented, no *prima facie* rejection of any dependent claim can be properly asserted. Consequently, reconsideration and withdrawal of these rejections is respectfully requested.

II. The Finality of the Office Action is Improper, Premature, and should be Withdrawn

A proper Office Action must be complete as to all matters, must provide a clear explanation of all actions taken, and must answer in detail the substance of each of Applicant's submitted arguments. See MPEP 707.07(f).

Except for a superficial and incomplete response to a portion of Applicant's arguments presented in the Reply filed 7 October 2005, this Office Action is a verbatim copy of the substance of the previous Office Action dated 27 July 2005. Although a substantive response to the 27 July 2005 Office Action was submitted, several of those arguments have not been addressed in the present Office Action.

Specifically, the Reply filed 7 October 2005 presented the arguments comprised in pages 12-18 relating to the nonobviousness of the claimed subject matter. The substance of these arguments is repeated herein.

Accordingly, the previous response filed 7 October 2005 is incorporated by reference herein and it is respectfully requested that a proper Office Action be provided, consistent with MPEP 707.07. In particular the argument related to a lack of motivation or suggestion to combine references has not been addressed in the present Office Action. Applicant respectfully submits that the finality of the present Office Action is improper, and Applicant respectfully requests that the finality of the present Office Action be withdrawn. Applicants further

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respectfully request the withdrawal of each of the rejections of claims 1-25, 27, 28, 30-40, 42, 43, and 45-62.

III. Allowable Subject Matter

A potential statement of reasons for the indication of allowable subject matter is:

“none of the references of record alone or in combination disclose or suggest the combination of limitations found in the independent claims. Namely:

claims 1-12 are allowable because none of the references of record alone or in combination disclose or suggest ‘determining that said specific instance is not registered with said second operating system and that said specific instance is already running under said first operating system; and utilizing a moniker, automatically registering said specific instance with said second operating system’;

claims 13-20 are allowable because none of the references of record alone or in combination disclose or suggest ‘determining that said specific instance is not registered in a running object table of said second operating system and that said specific instance is already running under said first operating system; and utilizing a moniker, registering said specific instance with said second operating system’;

claims 21-25, 27, 28, 30-35, 59, and 60 are allowable because none of the references of record alone or in combination disclose or suggest ‘a processor adapted to: register said specific instance with said first operating system; and via a moniker, provide access to said specific instance via a personal computer comprising a second operating system such that said specific instance of said

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object is accessible by a server associated with said personal computer by accessing a running objects table of said second operating system';

claims 36-40, 42, 43, 45-50, 61, and 62 are allowable because none of the references of record alone or in combination disclose or suggest 'processor means adapted to: register said specific instance with said first operating system; and via a moniker, provide access to said specific instance via a personal computer comprising a second operating system such that said specific instance of said object is accessible by a server associated with said personal computer by accessing a running objects table of said second operating system'; and

claims 51-58 are each allowable because none of the references of record alone or in combination disclose or suggest 'determining that said specific instance is not registered in a running object table of said second operating system and that said specific instance is already running under said first operating system; and utilizing a moniker, registering said specific instance with said second operating system.'"

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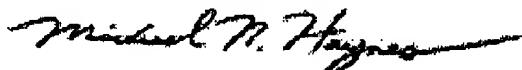
CONCLUSION

It is respectfully submitted that, in view of the foregoing amendments and remarks, the application as amended is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. 1.16 or 1.17 to Deposit Account No. 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

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Date: 16 February 2006

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